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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/445,268	04/03/2000	DANIEL RICHARD SCHNEIDEWEND	RCA89068	9731

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EXAMINER

DEMICCO, MATTHEW R

ART UNIT	PAPER NUMBER
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2697

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/445,268

Applicant(s)

SCHNEIDEWEND ET AL. 

Examiner

Matthew R Demicco

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2697

Period for Reply
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 April 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to because in Figure 11, the Element "1199" as disclosed on Page 27, Line 14, Page 28, Line 26, and Page 29, Lines 7 and 9 does not exist. Further, on Page 27, Line 18, Elements "1181" and "1182" disclose a clock face in Figure 11 which does not exist. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: Element 100 in Figure 3 is not disclosed in the specification. Similarly Element 311 in Figure 4 is not disclosed. In Figure 5, Elements 530 and 540 are not disclosed in the specification. Similarly, In Figure 6A, elements 603, 613, 617, 621, 623, 627, 628, 631, 635, 639, 660 and 670 are not disclosed in the specification. Also, in Figure 6B, elements 641, 643, 647, 660, and 670 are not disclosed. In Figure 7, elements 703, 711 and 713 are not disclosed. In Figure 8, element 814 is not disclosed. Lastly, in Figure 11, elements 1180 and 1180 are not disclosed. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,850,218 to LaJoie et al.

Regarding Claim 1, LaJoie discloses an apparatus for receiving a plurality of programs comprising a user interface for selecting a program from a plurality of programs and selecting a user action (See Figure 16). LaJoie also discloses a controller, which in response to a first user action for selecting a first program for recording, stores the first program in a first list representing a list of programs to be recorded (Col. 21, Lines 15-23). In response to a second user action for selecting a second program for both purchasing and recording, the controller stores the second program on a second list representing a list of programs purchased and also stores the program on the first list (Col. 29, Lines 33-58 and Figures 12 and 13).

Regarding Claim 2, LaJoie discloses a system as stated above in Claim 1 wherein the first list includes a timer conflict indication for programs having a timer conflict (Col.21, Lines 30-42 and Figure 12).

Regarding Claim 3, LaJoie discloses a system as stated above in Claim 1 wherein the first list includes a purchase indication for the second program (See Figure 14).

Regarding Claim 4, LaJoie discloses a system as stated above in Claim 1 wherein the controller first determines whether there is a timer conflict between the second program and another program on the first list before storing the second program on the first list (Col. 21, Lines 30-55).

Regarding Claim 5, LaJoie discloses a system as stated above in Claim 1 wherein the controller prompts a user to resolve the timer conflict if one exists (Cols. 21-22, Lines 55-5 and Figure 12).

Regarding Claim 6, LaJoie discloses an apparatus for processing a program comprising a controller for displaying a first list representing programs selected for recording (See Figure 12), displaying a second list representing programs selected for purchasing (See Figure 13) and in response to a user selection of a program for both purchasing and recording, automatically entering the program into both lists as stated above in Claim 1.

Regarding Claims 7-10, see Claims 2-5 respectively, as stated above.

Regarding Claim 11, LaJoie discloses an apparatus for processing a plurality of programs comprising a user interface means for selecting a program from a plurality of programs and for selecting a user action as stated above in Claim 1. Further, LaJoie discloses a controller as stated above in Claim 1 wherein a user can select a first program for recording which is stored in a first list and a second program for purchasing and recording which is stored on both a second and first list. LaJoie also discloses a controller, which, in response to a first user action for canceling a first program for recording, removes the first program from a first list representing a list of programs to be

recorded (Col. 22, Lines 52-56). Because LaJoie discloses adding a second program to both a first list of programs to be recorded and a second list of programs to be purchased in addition to disclosing the ability to cancel programs to be purchased (Col. 22, Lines 25-28), it is inherent that the program being purchased, if being recorded, would be removed from both lists by a determination means. If this feature were not present, the set-top box would try to record a pay-per-view program that had no prior purchase arrangements resulting in an error. This reads on a controller, in response to a second user action for canceling a second program for purchasing, removes the second program from a second list representing a list of programs purchased and also removes the second program from the first list if it appears on the list.

Regarding Claim 12, LaJoie discloses an apparatus for processing a program comprising on screen display means for displaying a first list representing programs selected for recording and on screen display means for displaying a second list representing programs selected for purchasing as stated above in Claim 6. LaJoie further discloses user control means for removing a program from the first and second lists and control means, which in response to the user removal of the program from the second list, automatically removes the program from the first list if the program appears as stated above in Claim 11.

Regarding Claim 13, LaJoie discloses a method for processing a plurality of programs comprising the steps of selecting a first program for recording from a plurality of programs, storing the program in a first list, selecting a second program for both purchasing and recording, storing the second program in a second list representing

programs purchased, and storing, automatically, the second program in the first list as stated above in Claim 1.

Regarding Claim 14, LaJoie discloses a method as stated above in Claim 13 further comprising the step of determining whether there is a timer conflict between the second program and another program on the first list before storing the second program on the first list as stated above in Claim 4.

Regarding Claim 15, LaJoie discloses a method as stated above in Claim 13 further comprising the step of prompting the user to resolve a timer conflict if one exists as stated above in Claim 5.

Regarding Claim 16, LaJoie discloses a method for processing a plurality of programs comprising selecting a first program for removing from a first list representing a program list of programs selected for recoding, selecting a second program for removing from a second list representing a list of programs purchased, and determining whether the second program appears on the first list and automatically removing it if so as stated above in Claim 11.

Regarding Claim 17, LaJoie discloses a method of processing a program comprising removing, in response to a user command, the program from a first list of programs representing programs scheduled for recording (Col. 22, Lines 52-56). Further, LaJoie discloses a controller as stated above in Claim 1 wherein a user can select a first program for recording which is stored in a first list and a second program for purchasing and recording which is stored on both a second and first list. LaJoie also discloses a controller, which, in response to a first user action for canceling a first program for

recording, removes the first program from a first list representing a list of programs to be recorded (Col. 22, Lines 52-56). Because LaJoie discloses adding a second program to both a first list of programs to be recorded and a second list of programs to be purchased in addition to disclosing the ability to cancel programs to be recorded (Col. 22, Lines 52-56), it is inherent that the system of LaJoie would have determining means for removing a program from a second list of programs to be purchased if the program was removed from the first list. This would be necessary in order to prevent a condition where a user inadvertently pays for a pay-per-view video without actually ever watching or recording it. This reads on the claimed method of determining whether the program is also a purchased program, and removing, automatically, the program from a second list of programs representing purchased programs, if the program is also a purchased program.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. U.S. Patent No. 5,537,473 to Saward discloses a video recording system for receiving pay television with stored lists of authorized payments.
- b. U.S. Patent No. 5,00,384 to Durden et al. discloses a pay-per-view system where the subscriber may pre-buy events to be recorded at a later time.
- c. U.S. Patent No. 6,141,488 to Knudson et al. discloses an interactive program guide that handles recoding of pay-per-view programs.

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d. U.S. Patent No. 6,157,413 to Hanafée et al. discloses a television system with recoding and payment data for pay-per-view programming.

e. U.S. Patent No. 6,208,799 to Marsh et al. discloses a set-top television system with recording functions that handle time-slot conflicts with a user alert.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155. The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5359 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



mrd
May 13, 2003



Kimberly A. Williams
Primary Examiner
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